



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Pat nt and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
097316,851	05/21/99	BUI	003542.P002

QM31/0928  
BLAKELY SOKOLOFF TAYLER & ZAFMAN LLP  
12400 WILSHIRE BOULEVARD  
7TH FLOOR  
LOS ANGELES CA 90025

EXAMINER  
THOMPSON, M

ART UNIT  
3763

PAPER NUMBER

DATE MAILED: 09/28/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/316,851**

Applicant(s)

**Bul**

Examiner  
**Michael M. Thompson**

Group Art Unit  
**3763**



☒ Responsive to communication(s) filed on Jun 27, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-32 is/are pending in the applicat

Of the above, claim(s) 24-32 is/are withdrawn from consideration

☐ Claim(s) is/are allowed.

☒ Claim(s) 1-23 is/are rejected.

☐ Claim(s) is/are objected to.

☐ Claims are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 3763

## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election of Group I, Claims 1-23 in Paper No. 4 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 24-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected method for controlling pressure, there being no allowable generic or linking claim. The election was deemed an election **without** traverse in Paper No. 4.

### ***Claim Rejections - 35 U.S.C. § 102/103***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3763

5. Claims 1-2, 4-6, 8-10, 13, 14, 16-18, 21, and 22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Costin ('256).

Costin teaches an "irrigation system" with a reservoir, pump line coupled to the pump, pressure sensor, accumulator, controller coupled to pressure sensor, aspiration system, pump, line, and pressure sensor and a medical device coupled to both the irrigation line and aspiration line. Costin teaches a flexible membrane (Figure 10) separating a first and second chamber and in communication with the pressure transducer/sensor, and irrigation line. He teaches a controller that varies the pump, determines a flowrate, by providing output signals. In the alternative, it is the Examiner's position that the Costin patent teaches all of the structural limitations of the claims and their functions, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Please note it has also been held that mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

6. Claims 3, 7, 11, 15, 19, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Costin in view of Voss et al.. Costin teaches all of the limitations of the claims except for explicitly stating that the controller determines an actual fluidic resistance from the flowrate and provides an output signal. Voss et al. teaches a fluid flow device that monitors fluidic resistance through the monitoring of the impedance to fluid flow. Voss et al. teaches that a device containing an impedance monitor can detect the fluids "fluidic resistance" and calculate a resistance to flow. Costin teaches a second embodiment of his device containing an impedance

Art Unit: 3763

monitor in Figure 8. Therefore, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art, at the time of invention, to have modified (if needed) the impedance monitor of Costin, with the impedance and fluidic calculator of resistance to allow the Costin device to monitor fluidic resistance since it well known in the art of fluid flowing systems to monitor impedance as taught by Costin, if not calculate fluid resistance as explicitly taught by Voss et al. With respect to a valve mechanism coupled to the irrigation line, the Examiner maintains that valves are well known in the art, and are attached to all types of fluid flow devices to prevent backflow, maintain pressure, prevent contamination, to include several other purposes.

#### *Contacts*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thompson whose telephone number is (703) 305-1619. The examiner can normally be reached on Monday through Friday from 9 am to 5 pm. The fax phone number for the organization where this application or proceeding is assigned is (703) 306-4520.

Michael M. Thompson

Patent Examiner

MT 

September 20, 2000

  
Sharon Kennedy  
Primary Examiner